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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/251,274 02/16/99 DI RIENZO

A 27373/35172

EXAMINER

HM12/0625

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ART UNIT

PAPER NUMBER

1655

DATE MAILED:

06/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/251,274

Applicant(s)

Di Rienzo et al.

Examiner

Arun Chakrabarti

Art Unit

1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 5, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jun 5, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).

6. ☒ The a) ☒ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-62 and 70-75

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

11. ☐ Other:

JEFFREY FREDMAN
PRIMARY EXAMINER

The after final amendment submitted on June 5, 2001, has been entered but does not place the application in condition of allowance because the applicant provided the same 131 declaration which was submitted before the final rejection. The applicant has attached a copy of the slides (Exhibit B) that were presented on March 30-April 1, 1998 in New Orleans, Louisiana at the American Society for Clinical Pharmacology and Therapeutics meeting.

It was addressed in the last office action why the 37 CAR 1.131 affidavit or declaration presented by the applicant clearly failed to establish possession of either the whole invention claimed or something falling within the claim. With regard to the attached a copy of the slides (Exhibit B) that were presented on March 30-April 1, 1998 in New Orleans, Louisiana at the American Society for Clinical Pharmacology and Therapeutics meeting, applicant is hereby advised that facts and documentary evidence presented are not sufficient to show earlier possession of the invention, as MPEP 715.07 recites, "The essential thing to be shown under 37 CAR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following: A) attached sketches; B) attached blueprints; C) attached photographs; D) attached reproductions of notebook entries; E) an accompanying model; F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d1075 (Bd. Pat. App & Inter. 1989); G) testimony given in an interference; H) Disclosures documents (MPEP 1706) may be used as documentary evidence of conception." In this case, no FACTS have been alleged by any kind of documentary evidence to demonstrate the essential part of the claim, "the presence of

eight repeats correlates with decreased expression of the gene”.

It is the showing of correlation which is lacking. In order to antedate the art, possession of the invention, as noted by the MPEP quoted above, must be shown. No possession of the correlation was shown. Therefore, the declaration under 1.131 filed on June 5, 2001, is not persuasive.